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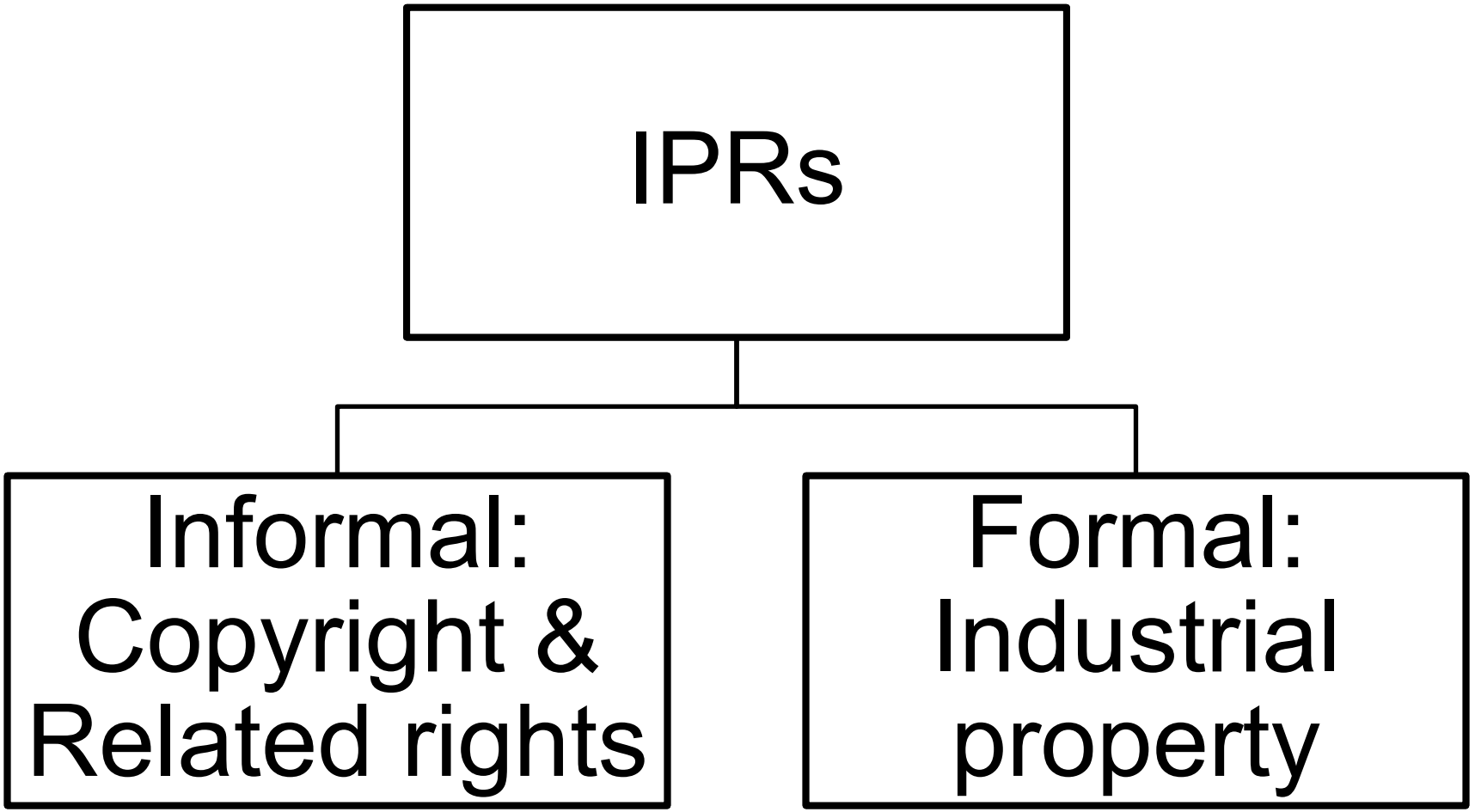
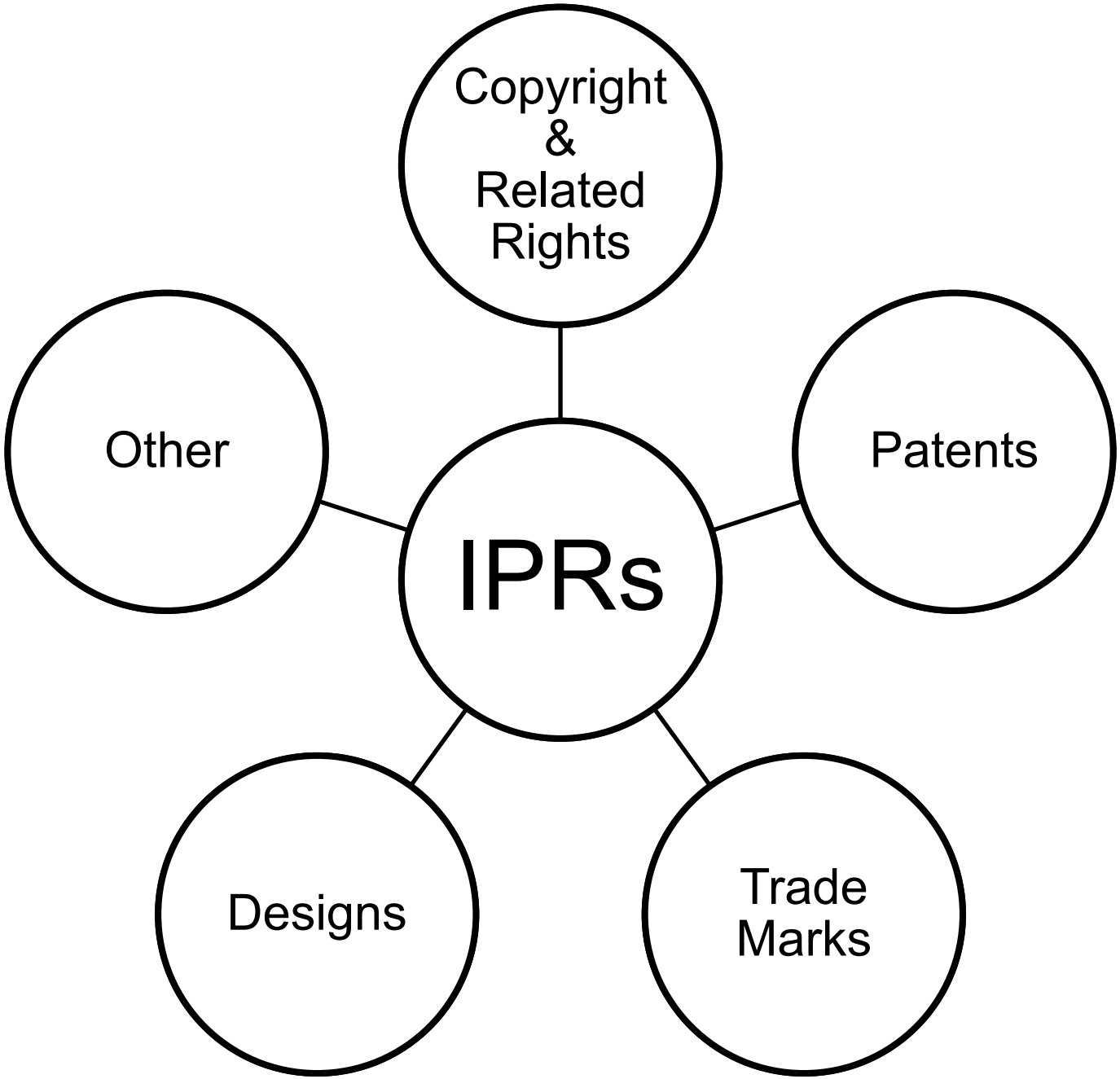
IP Law

Matěj Myška


IPRs
Informal: Copyright & Related rights
Formal: Industrial property


Copyright & Related Rights
Other
IPRs
Patents
Designs
Trade Marks

Issue of territoriality

No “global” IPRs

Territoriality based protection

Overcoming territoriality

International treaties

National treatment (minimum rights)

Easier grant procedure

International, regional, national filing

Industrial Property Rights

General Procedure

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Types of registration

National

Regional

International

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Patents

Requirements for protection

Protectable subject-matter
Novelty
Inventive step
Industrial applicability

Patentable invention (subject matter)

Inventions solving non-technical problems relying on subject matter void of any technical character are not eligible for a patent.

A52(1)

European patents shall be granted for any inventions, in all fields of technology, provided that they are

- new,
- involve an inventive step and are
- susceptible of industrial application.

A52(2)

The following in particular shall not be regarded as inventions within the meaning of paragraph 1:

(a) discoveries, scientific theories and mathematical methods;

(b) aesthetic creations;

(c) schemes, rules and methods for performing mental acts, playing games or doing business, and programs for computers;

(d) presentations of information.

A52(3)

Paragraph 2 shall exclude the patentability of the subject-matter or activities referred to therein only to the extent to which a European patent application or European patent relates to such subject-matter or activities **as such**.

Novelty – A54

(1) An invention shall be considered to be new if it does not form part of the state of the art.
(2) The state of the art shall be held to comprise everything made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application.

Inventive step – A56

An invention shall be considered as involving an inventive step if, having regard to the state of the art, it is not obvious to a person skilled in the art.

Industrial application – A57

An invention shall be considered as susceptible of industrial application if it can be made or used in any kind of industry, including agriculture.

Grant procedure

National
European Patent (European Patent Convention) – not an EU Patent, international agreement
Filing, Search, Examination, Grant, Opposition

Protection: scope protection & term & exceptions

20 years from filing
Yearly fees
Exceptions: experimental & private use (national law)

Biotech inventions

Directive 98/44/EC — legal protection of biotechnological inventions

“Inventions which concern a product consisting of, or containing, biological material or a process for the production of such biological material may be patented if they are new, involve an inventive step and can be applied industrially.

The following are not patentable:

- *plant and animal varieties*
- *essentially biological processes* for producing plants and animals*
- *the human body at the various stages of its formation and development.*

However, an element isolated from the human body or produced by a technical process may be a patentable invention.

Inventions may not be patented where their commercialisation would be immoral or against public order. In particular, the following are not patentable:

- *processes for cloning human beings*
- *processes that modify the human germ line genetic identity*
- *use of human embryos for industrial or commercial purposes*
- *processes that may cause suffering to animals when modifying their genetic identity.“*

Source: https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=LEGISSUM:l26026

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Copyright & Related Rights

FOCUS

Directive on the harmonisation of certain aspects of copyright and related rights in the information society ("ISD"), 22 May 2001
Directive on the legal protection of computer programs ("SD"), 23 April 2009
Directive on the legal protection of databases ("DD"), 11 March 1996

Rights granted – ISD

A2 Reproduction right
A3 Communication to the public
A4 Distribution right
Not only for copyright, but also for related rights

Exceptions

Reproduction/Communication to the public

Quotation
Teaching
Research
…

Term

Term directive: extended term to 70 years p.m.a. (Berne requires 50 years)
Prolonging of performers' and sound recording rights from 50 to 70 years in 2011

Plagiarism: Intersection Law/Ethics

Expression/idea dichotomy

MU academic and professional employee code of ethics

https://www.muni.cz/en/about-us/official-notice-board/mu-academic-and-professional-employee-code-of-ethics

Types of plagiarism

Academic misconduct X Copyright infringement

Internal mechanisms (damage to reputation) X Legal proceedings

Copyright protection for software

What is protected?

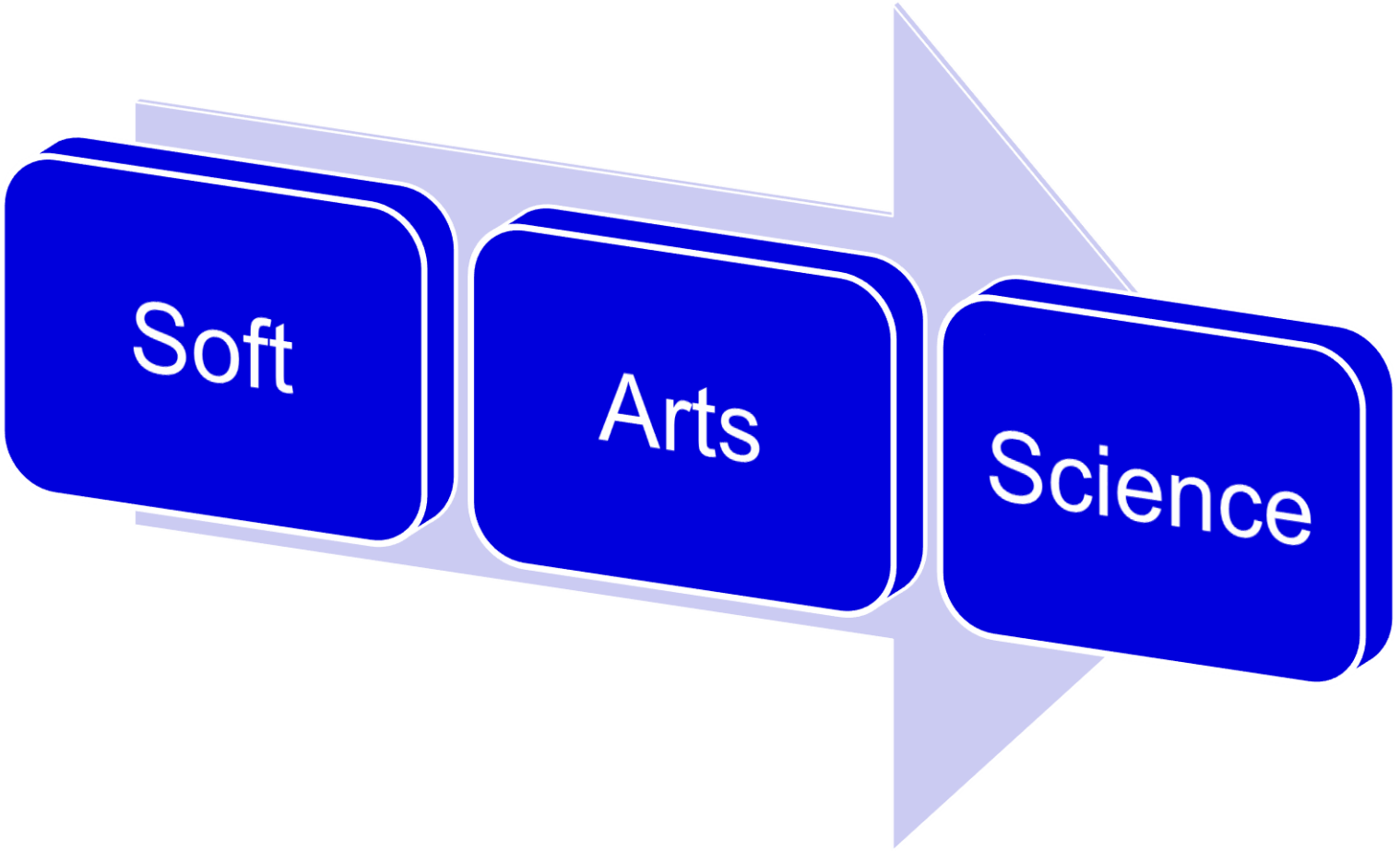
YES	No
-Expression of a computer program -Binary Code -Source code -Preparatory underlying materials	-Ideas -Principles -Logic -Algorithms -Programming languages -Data formats -GUI

Related rights

- Performers
- Producers of phonograms
- Broadcasters
- Audiovisual fixation producers

Alternative approaches to licensing in copyright

Open Content

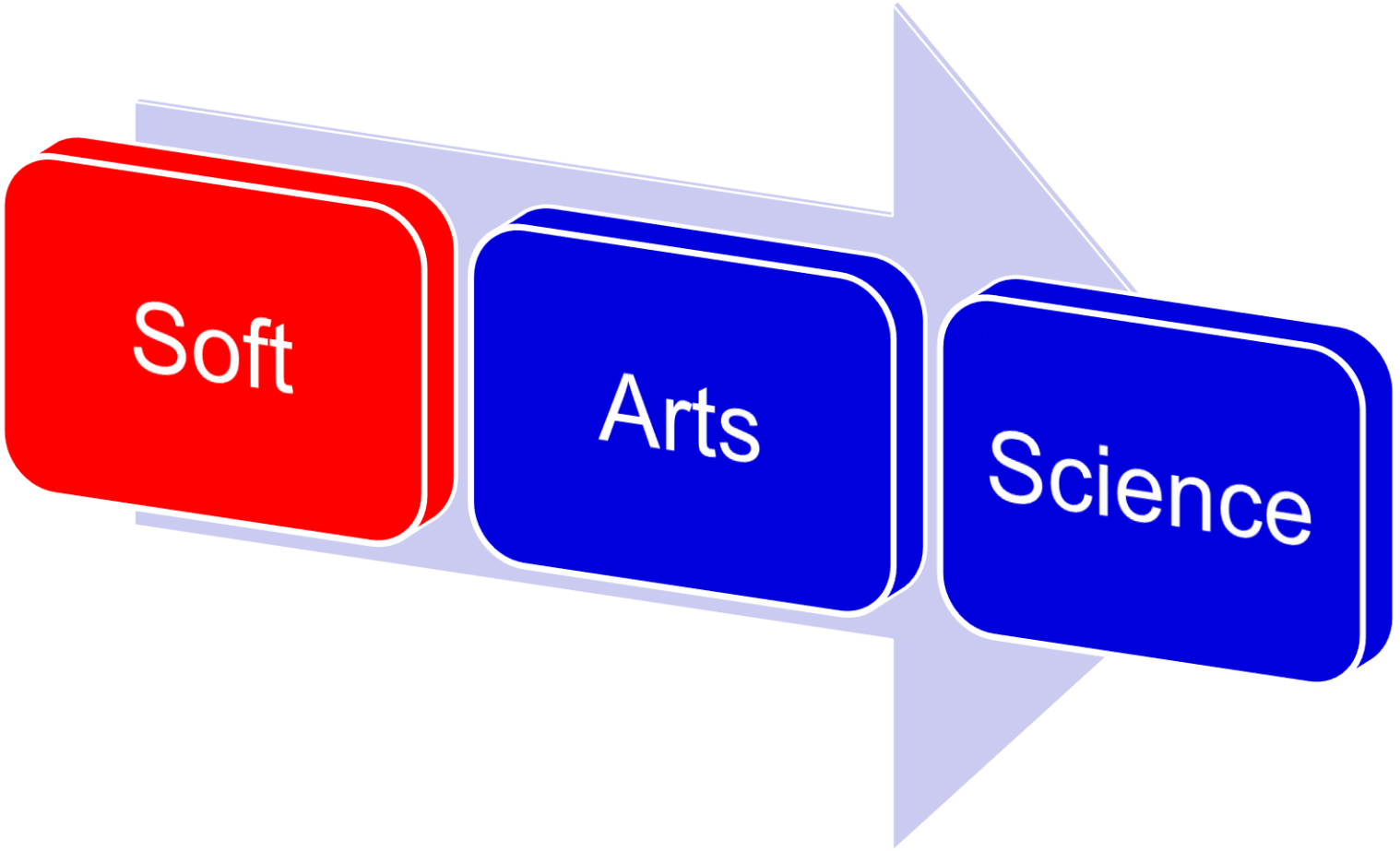


Open Content Definition v2

RETAIN
REUSE
REVISE
REMIX
REDISTRIBUTE

David Wiley, http://opencontent.org/definition/

Open Content - Software



Legal Aspects

Copyright

Licences

Copyleft effect / Share-alike

Various types of licences

opensource.org/licenses/alphabetical

Copyleft Effect

GNU GPL v2.0
"Art. 2 b) You must cause any work that you distribute or publish, that in whole or in part contains or is derived from the Program or any part thereof, ***to be licensed*** *as a whole at no charge to all third parties* ***under the terms of this License****."*

Legal typology

Strongly protective licences

"viral licences"
GNU General Public License

Weakly protective licences

Lesser General Public License (LGPL)

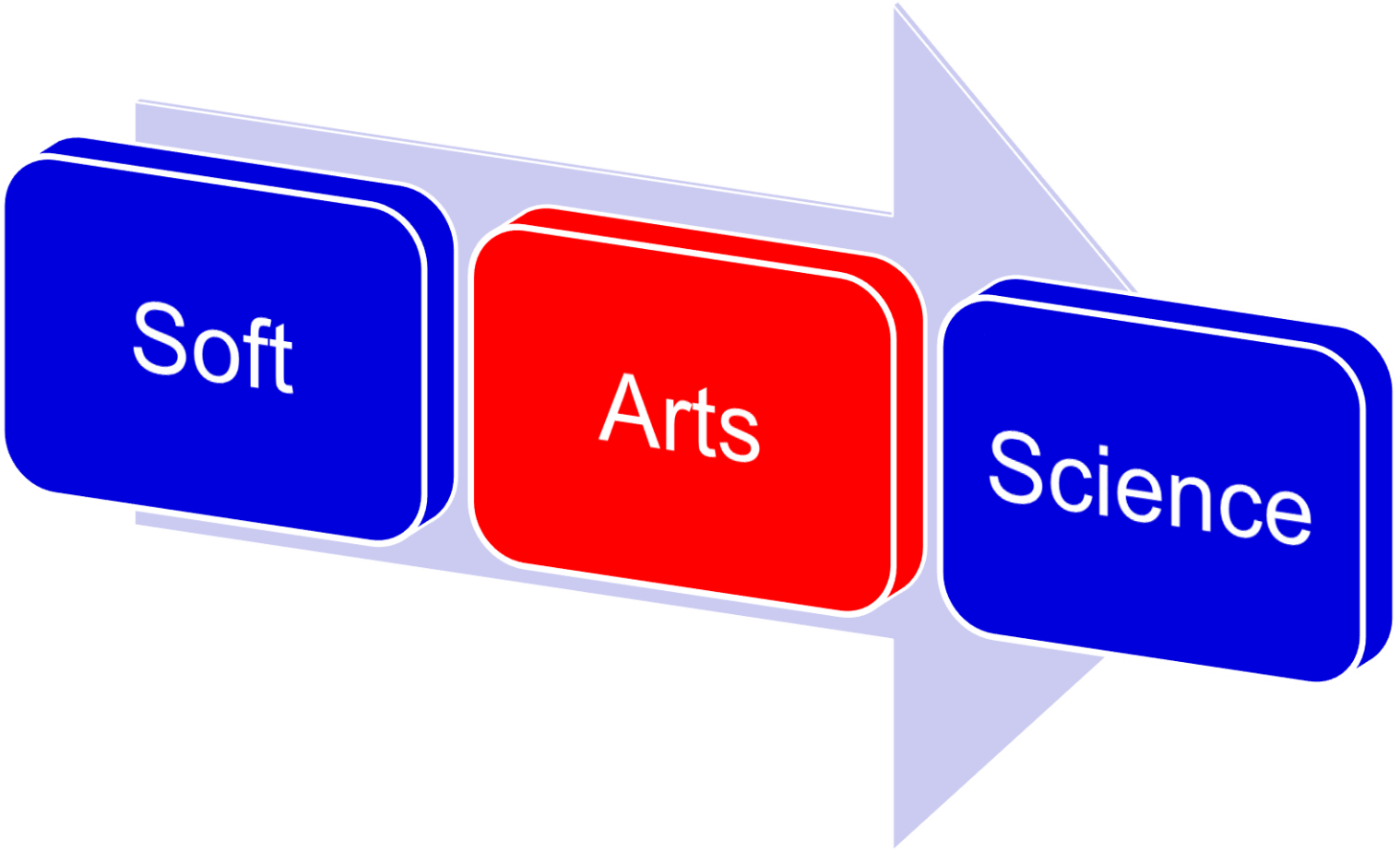
Permissive licences

Author's crediting
BSD License, MIT License

Legal Issues

- Enforceability
- Multi-licensing
  - Mozilla Suite / tri-license
- Liability and Warranty Disclaimers
- Copyright / Droit d'auteur

Open Content – Arts



Public licences – characteristics

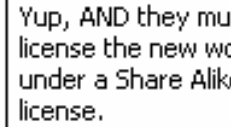
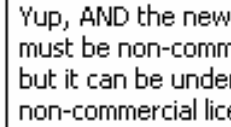
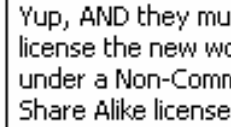
Allow sharing (modification)
Under specific conditions
Always attribution
Irrevocable
Automatic termination upon breach

Creative Commons
https://creativecommons.org/choose/

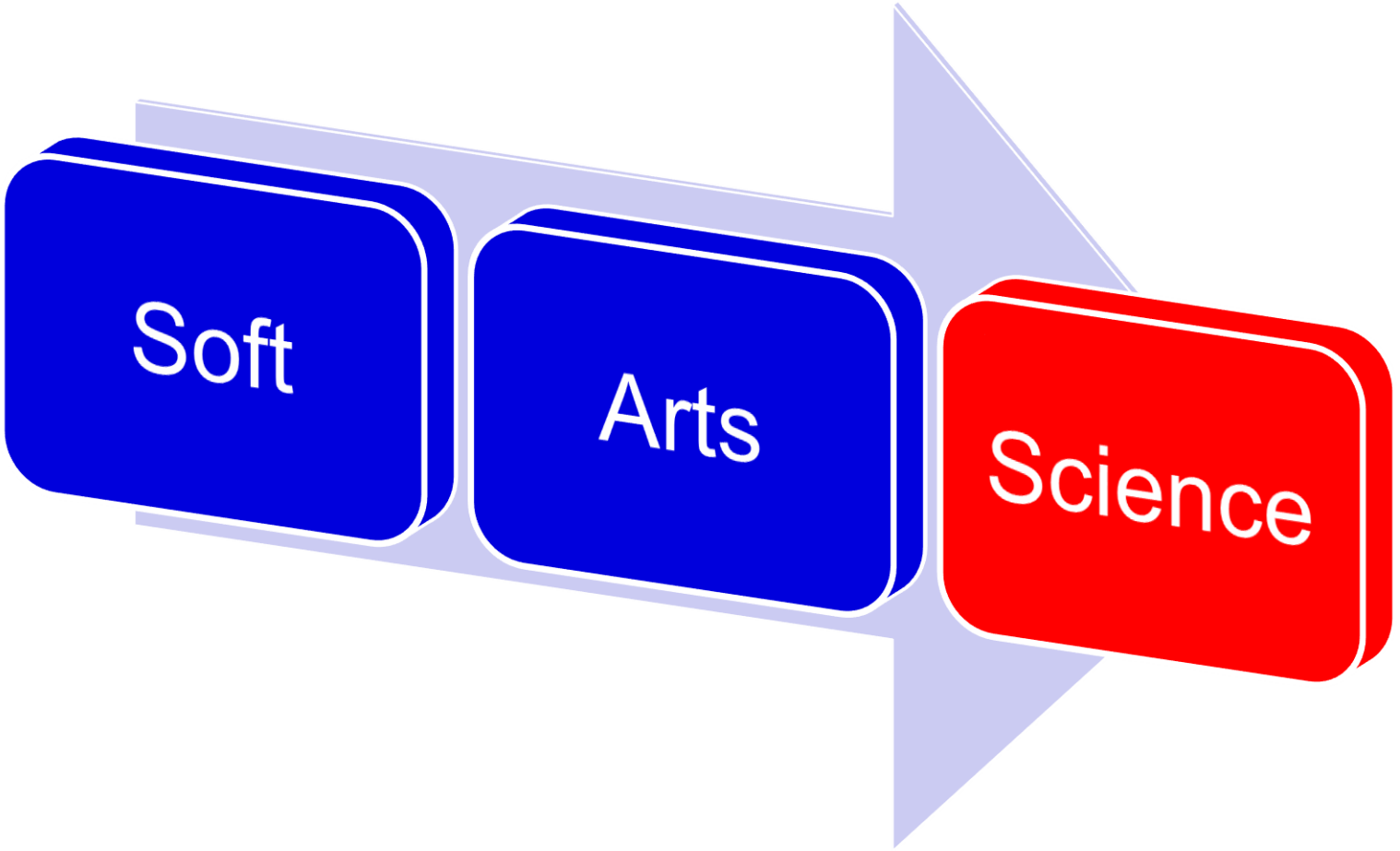
Creative Commons overview

2001 in USA
2009 in CZ
Public license
Sec. 2371 CzCA

Source:
https://i.pinimg.com/736x/fc/37/0b/fc370bc5c135416e38821dd630d2d0f3--copyright-license-creative-commons-images.jpg

	Can someone use it commercially?	Can someone create new versions of it?
Attribution		
Share Alike		Yup, AND they must license the new work under a Share Alike license.
No Derivatives		
Non-Commercial		Yup, AND the new work must be non-commercial, but it can be under any non-commercial license.
Non-Commercial Share Alike		Yup, AND they must license the new work under a Non-Commercial Share Alike license.
Non-Commercial No Derivatives		

Open Content – Science



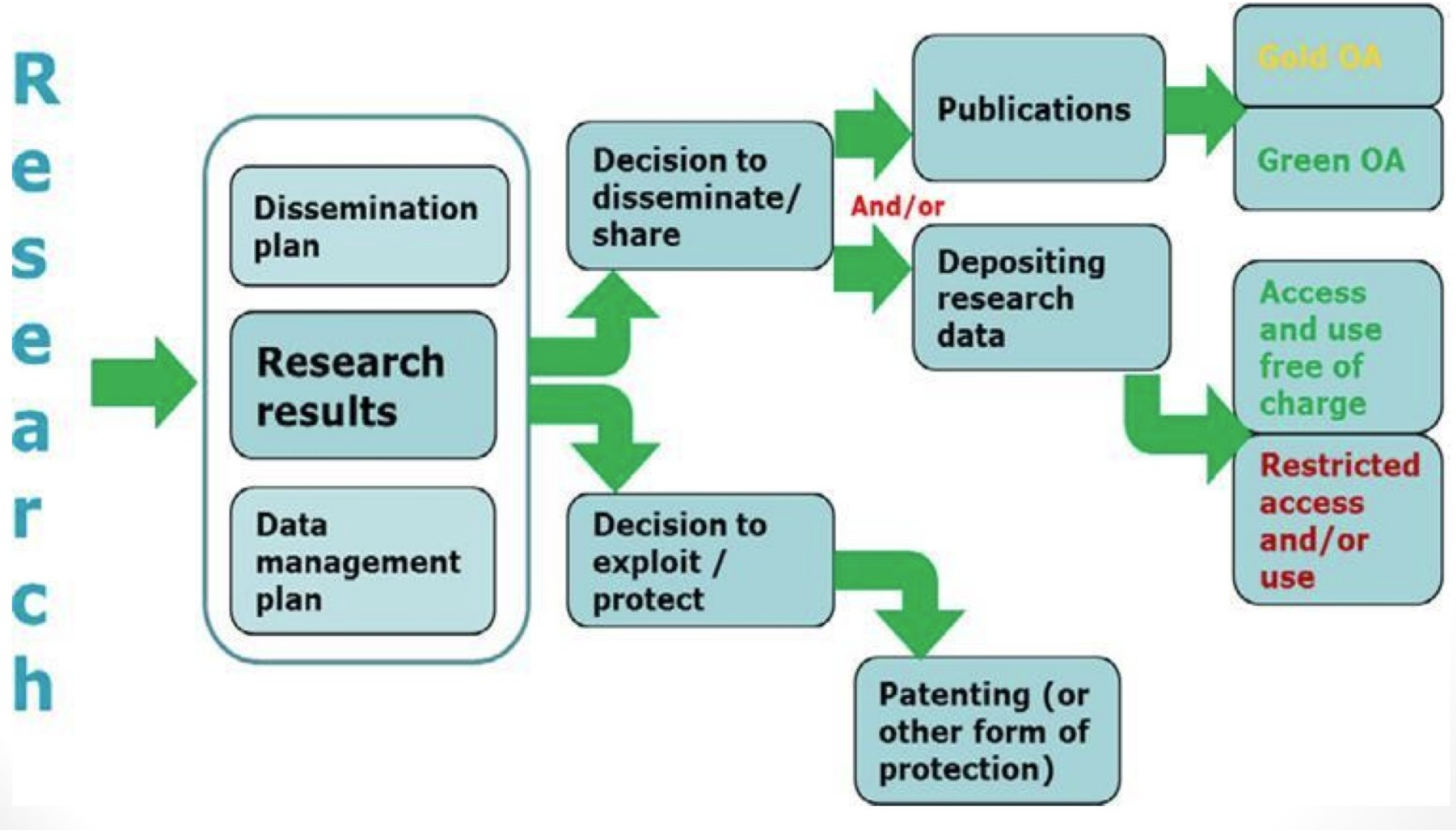
Science

Open Access

Green – auto-archiving of post-prints (after reviews)
Golden – publications of journal versions of the text

Legal Issues

Who can license?



Source: Guidelines on Open Access to Scientific Publications and Research Data in Horizon 2020, p. 4. Available from: http://ec.europa.eu/research/participants/data/ref/h2020/grants_manual/hi/oa_pilot/h2020-hi-oa-pilot-guide_en.pdf

IP in Science

IPR Related Terminology

What do all the specific terms such as *background/foreground* in the project documentation mean?

Specific (non-binding) terms

Results (foreground)
Background
Access rights
Dissemination
Exploitation - Commercialization

IP AT MU

How do we deal with results/IP on MU? How can/shall I share my scientific results?

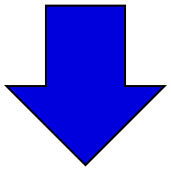
Fundamental Document

MU Directive No. 10/2013: Intellectual property at Masaryk University
https://is.muni.cz/auth/do/mu/Uredni_deska/Predpisy_MU/Masarykova_univerzita/Smernice_MU/SM10-13/108375276/MU_Directive_No._10_2013_-_Intellectual_Property__1.1.2021_.pdf?lang=en

Sets out rights and obligations associated with:
creating,
notifying,
registering,
protecting and using
of intellectual property.

HIERARCHY

Grant Conditions + Other Agreements shall prevail



MU Directive 10/2013

INFRASTRUCTURE FOR IP

MU Technology Transfer Office ("TTO")

University Economic Units of MU ("UEU")

Contact person for IP and TT

Full-list: https://www.ctt.muni.cz/en/intellectual-property/contact-persons

Masaryk University Publishing House ("MUPH")

YOU! (should cooperate:)

VERY BASIC LAYMEN INFO ABOUT IP

IF you are an employee the rights are regularly vested in the MU.
IF you are a student of MU the rights are regularly yours, however MU is entitled to ask you for a license.

SLIGHTLY MORE SOPHISTICATED INFO ABOUT USE OF INTELLECTUAL PROPERTY

INTERNAL

general use of intellectual property for the needs of MU

EXTERNAL

use of intellectual property by an entity distinct from MU:

(1) transfer of rights
(2) licence
(3) another contract
(4) transferring a MU share in a spin-off
(5) providing services

COMMERCIAL
NON-COMMERCIAL (gratuitous)

Dealing with INDUSTRIAL PROPERTY

As an employee you are **obliged to notify MU** in writing about anything created that may be a subject of industrial property

Report of Invention (Art. 5 MU-IP-DIR Notification about the creation of industrial property)

Assessment of an invention – TTO

"Opinion on exercising a MU right to industrial property"

Rector (or TTO Director) decides about excercising the right to the subject of industrial property

Cooperation with patent attorney in filing an application - TTO

DEALING WITH COPYRIGHTED WORKS

LAYMEN SUMMARY

Journal articles, conference proceedings – you are the one in charge, you decide, you sign the licensing agreement
BEWARE – Joint authorship! (i.e. other authors)
Other works: head of the UEU (dean) is the one who decides about everything
Institutional repository for realizing Open Access
http://is.muni.cz/repozitar/?lang=en
DATABASES: All rights vested in MU

Dealing with Copyrighted Works

MU exercises, in its own name and on its own account, author's economic rights to copyrighted works, which are employee works. – HEAD of the UEU decides

Works that were created for the purpose of publication in scientific journals or conference proceedings –

exercise of economic rights left to the author – AUTHOR (Employee) decides

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Technology transfer and commercialisation

[Slides in this part were created by the CTT / Ondřej Woznica]

University role

- Education (primary)
- **research and development** (secondary)
- **dissemination of results and knowledge** (secondary)

⇒one of the ways to ensure the dissemination of R&D results into practice can be their targeted transfer from the university environment to the "outside" in the form of spin-off companies

⇒so-called knowledge/technology transfer and IP commercialisation

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Technology Transfer (TT)

= transfer of scientific results into practice

- dissemination → exploitation → share
- most often:
  - technical solutions (inventions, patented)
  - scientific research findings and experience
  - software
  - know-how (data, methodologies, algorithms, etc.)

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The "broader concept" of TT

- Contractual research (research on private request)
- collaborative research (in cooperation)
- **licensing**
- **transfer/sale of IP**
- **establishment of a legal entity** (spin-off)
- publication and presentation of results
- teaching
- networking/events

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Commercialisation of scientific results

= specific commercial form of TT

- basic assumptions:
  - I have a scientific result (usually a technical solution or software)
  - at some later stage of development (prototype)
  - potentially applicable in practice with market potential
  - (not yet published)

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Licensing

- granting a licence to a third party allows it to use MUNI's intellectual property to the extent and for a fee
  - right of use, MUNI remains the owner
- the licensee pays royalties by mutual agreement
  - one-off, milestone, percentage of revenues
- the industrial rights licence must be registered in the register of the Industrial Property Office

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Transfer/Sale

- transfer of the right of ownership for consideration
  - not just the right of use as in the case of a licence
- as regards formal protection (patent), the acquirer registers with the Industrial Property Office
- the full cost of maintaining the protection is then passed on to the acquirer, but MU can negotiate the same payments as for a licence
  - one-off, milestone, percentage of revenue

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Establishment of a legal entity (spin-off)

- spin-offs are usually established for the purpose of more efficient management of MUNI IP
- there should be an improvement in production and product development
  - university is not a manufacturing company (it does not have the capacity to produce, nor is it its task to do so)

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True/untrue Spin-offs

- spin-off with MU share (so-called true/authentic)

  vs. spin-off without MU share (so-called

  inauthentic/untrue)

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To commercialize or not to commercialize?

- the basic idea - how to deal with the result:
  - make it public (e.g. publish) and not commercialize it
  - provide formal protection (e.g. patent) and commercialise
  - do not protect formally and commercialise e.g. as know-how through a licence
  - not commercialise but develop further, possibly in collaboration with other departments or a company (collaborative research), while maintaining confidentiality, and possibly commercialise later

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Criteria and limits

- **the nature of IP**: what is legally possible (Copyright x Patents)
- **public law limits**: due diligence, unlawful public aid, etc.
- **third party rights**: co-authorship, co-ownership, existing obligations, third party rights affected
- **source of funding**: subsidy rules, grant schemes, project commitments, sustainability
- **internal rules of the institution**: internal rules, IS, processes and mechanisms

Criteria and limits

- **Stakeholder positions and interests**: scientist/author vs. institute management vs. faculty management vs. university management vs. TTO vs. market
- **Market potential:** real chance of success in the market, applicability and applicability
- **economic sense and pricing:** cost, feasibility
- **demand/interest:** business negotiations
- **state of development and technology readiness:** a 9-step scale is used to assess the maturity of the technology = Technology Readiness Level (TRL)

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What's it all good for

- direct **financial income** for the institution
- points from reporting applied R&D results in **RIV**
- **prestige**, success, PR
- Potential **financial income for scientists** (settlement of originators)
- grants, subsidies
- evaluation of HEIs according to the **M17+ Methodology** (module 3 - social relevance)
- the **result would otherwise not have reached the market in the form of a product** (especially a drug)
- scientific progress
- benefit to society

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MASARYK UNIVERSITY IP SUPPORT

FINALLY:
Who can help me with all that?

Who and when can help you

Writing project proposal:

Contact the Research & Development Office - Rector's Office

IPR issues – TTO

Exploitation of results:

IP Contact person

TTO

Dissemination

IP Contact person

MUPH

University Economic Unit

IP Contact Person
Helps with communication with TTO

Technology Transfer Office

www.ctt.muni.cz
In detail:

Technology Transfer Office
Masaryk University
Žerotínovo nám. 9
(Komenského nám. 2)
601 77 Brno
Czech Republic
ctt@ctt.muni.cz

CONCLUSION

DO's

Follow the Directive 10/2013

Contact the IP Contact Person

Contact TTO

DON'Ts

Publish (!) without prior consultation with IP Contact Person/Partners if potentially patentable

Present (!) commercially interesting inventions without contacting TTO

Thank you for your attention!

myska@ctt.muni.cz / matej.myska@law.muni.cz